

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 09/997,450
Applicant: Shamim M. Malik et al.
Filed: November 30, 2001
Art Unit: 3731
Examiner: Ryan J. Severson
Docket No.: 050623.00061
Confirmation No.: 3442
Customer No.: 45159
Title: A Modified Surface For An Implantable Device And A Method Of
Producing The Same

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

An Appeal Brief was submitted on October 12, 2009 pursuant to the Notice of Appeal that was filed on August 10, 2009. On January 13, 2010, the Examiner filed an Answer (Examiner's Answer) to which this Reply Brief is directed.

I. STATUS OF CLAIMS

Claims 11, 12, 15, 16, 20, 22, 23, 28 – 33, and 35 – 41 have been canceled without prejudice to reclaiming the subject matter therein in a subsequent application.

Claims 1, 7 – 10, 13, 14, 17, 18, 26, 27, 34, and 42 – 45 have been withdrawn by the Examiner as being drawn to a non-elected species.

Claims 2 – 6, 19, 21, 24, and 25 have been finally rejected and are the subjects of this appeal.

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The ground for rejection to be reviewed in this appeal is:

Whether claims 2 – 6, 19, 21, 24, and 25 are rendered obvious by, and are therefore unpatentable under 35 U.S.C. §103(a), Lazarov *et al.*, United States Patent No. 6,110,204 (Lazarov), in view of Malik *et al.*, *J. Vac. Sci. Technol. A*, **15**(6), Nov/Dec 1997 (Malik).

III. ARGUMENTS

Appellants believe that the Appeal Brief previously submitted addresses the Examiner's rejection. However, the Examiner has responded in an Examiner's Answer to the arguments in the Appeal Brief in an attempt to further bolster his rejection. This Reply Brief addresses the Examiner's comments regarding Appellants' arguments.

The Examiner's Reply to Appellants' Argument

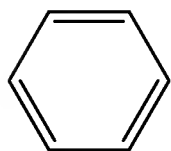
The Examiner has replied to the Appellants' argument that "the combination of Lazarov et al. and Malik et al. fail to disclose implanting the TiN within the surface of the stent." The Examiner has reiterated his position that "it would have been obvious to have implanted the TiN_xO_y within the surface of the stent." The Examiner has clarified his previous rejection by stating that "[t]he compound $[TiN_xO_y]$ comprises Ti and N, and also comprises TiN." In other words, it is the Examiner's view that "... if TiN_xO_y were implanted within the surface of the stent as suggested, inherently a first region (comprising Ti or N) is implanted within the stent, and inherently a second region (comprising TiN) is implanted within the stent, and the complete compound (TiN_xO_y) covers those regions." According to the Examiner, because the claims do not limit the "... implanting to only Ti or N (or the compound thereof), the prior art reads on the claims as presented." The Examiner further elaborates on his position by stating that "Ti and N are a part of the TiN_xO_y compound," and "a region is merely an arbitrary area." In other words, it is the Examiner's position that "implanting the compound TiN_xO_y within the surface of the stent inherently creates the 'tri-region construct'."

Appellants' Response

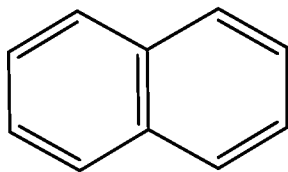
First, Appellants reiterate their position presented in the Appeal Brief. Malik does not disclose, and does not suggest, the implantation of Ti, TiN, or any other alloy of Ti. The Examiner admits that Lazarov does not disclose “the compound is implanted on a molecular level within the surface of the stent.” Thus, the references neither teach nor suggest implantation of TiN. Also, the references neither teach nor suggest implantation of TiN_xO_y , as asserted by the Examiner.

Second, even if the reference taught implantation of TiN_xO_y as asserted by the Examiner, a supposition with which Appellants do not concur, the Examiner's interpretation that Malik reads on Appellants' claims 19 and 21 is incorrect. As best understood by Appellants, the Examiner is stating that the disclosure of the implantation of TiN_xO_y reads upon implantation of Ti, implantation of N, and implantation of TiN as well as implantation of TiN_xO_y . Assuming that Appellants' understanding of the Examiner's interpretation is correct, the Examiner has reached this conclusion because the compound TiN_xO_y includes Ti and N.

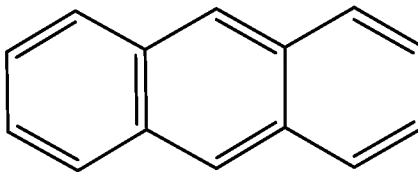
Interpreting the “implantation of TiN_xO_y ” as also disclosing or reading on the “implantation of Ti” and the “implantation of TiN” is clearly unreasonable and incorrect. Following the Examiner's logic, a claim to a composition “comprising benzene” would be anticipated by any composition including naphthalene or anthracene (see below) because naphthalene and anthracene have at least one aromatic ring like benzene.



Benzene



Naphthalene



Anthracene

Additionally, the Federal Circuit does not condone such an interpretation. In an analogous situation in Cohesive Technologies v. Waters Corporation, 543 F.3d 1351, 1362 (Fed. Cir., 2008), the Federal Circuit noted “. . . if a patentee disclaims ‘flammable substances like hydrogen’ during prosecution, the patentee has not disclaimed the nonflammable compound H₂O, just because it is two-thirds hydrogen.”

It is clear that the Examiner’s interpretation of Malik is unreasonable.

CONCLUSION

The Examiner has failed, as a matter of law, to set forth a case of unpatentability of claims 2 – 6, 19, 21, 24, and 25. Appellants therefore respectfully request that the Board reverse the Examiner's rejection and order that the application proceed to issue.

The Commissioner is hereby authorized to charge the **Squire, Sanders, and Dempsey Deposit Account No. 07-1850** for any fees due.

Date: March 11, 2010

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Respectfully submitted,

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